

REMARKS

Claims 1 to 20 were pending in the application at the time of the advisory action. Claims 19 and 20 remain rejected as anticipated. Claims 1 to 18 remain rejected as obvious.

Claims 1 to 5, 7 to 11, and 13 to 17 remain rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,377,354, hereinafter referred to as Nguyen, in view of U.S. Patent No. 5,959,857, hereinafter referred to as Speciner.

Applicant has amended independent Claims 1, 7, and 13 to incorporate the definition of "transparent graphics object" from the description, and have clarified that the transparent graphics objects contained in the transparency list are referenced in the list. In addition, the claim has been clarified to include that the transparency list is examined to determine whether the list is empty, and when the list is empty the document page is simply printed.

Claim 19 had been amended to include limitations equivalent to those described above with respect to the transparency list and the transparent object.

Claims 4, 10, 16, and 20 have been amended to correct informalities introduced by amendment of the independent claim from which each depended.

Applicant respectfully traverses the obviousness rejection of independent Claims 1, 7, and 13. Applicant respectfully notes that at no time has the rejection cited any teaching of differentiation between objects in Nguyen based upon transparency. The only citation has been to Fig. 4 and the word "transparently." These aspects of Nguyen cannot be considered in a vacuum and must be interpreted in view of the teachings of Nguyen as a whole. Figs. 3A and 3B describe the method taught by Nguyen and the only tests for differentiating between elements are tests for differentiating for between "text or graphics."

Moreover, the process of Nguyen does not rely upon any list but rather simply steps through checking each print object from a GDI to determine whether the object is graphics or text. Nowhere in the process of Figs. 3A and 3B has the rejection cited any operations associated only with objects in a list, let alone objects having a particular characteristic as recited in the claims. In each case, every graphics object (test 148, Fig. 3B) and every text object (test 122, Fig. 3A) is checked by Nguyen for overlap and then the object is used in updating a bitmap when there is an overlap. This fails to suggest or disclose performing any operation only when a transparency list is not empty and converting objects in the list when the list is not empty.

Further, a bit map buffer is not a transparency list. The secondary reference makes this clear by differentiating between a display list 16 and a frame buffer. Accordingly, the characterization of the bitmap buffer of Nguyen goes against the teaching in the secondary reference. In addition, the rejection has failed to show that the bitmap buffer of Nguyen has any references to any of the graphics or text of Nguyen.

Contrary to the statements in the advisory action, the secondary reference does not distinguish between text and graphics with respect to what is put in the list. Rather "a working display list 16 of text and graphic object definitions" is described (See U.S. Patent No. 5,959,867, Col. 6, lines 5 and 6). Thus, the reference teaches that definitions of both graphic objects and text are stored in the list and not references to particular objects as recited in Applicant's claims. Thus, the rejection requires a modification to change the list of the secondary reference and then insertion of such a modified list into Nguyen that does not use a list. The MPEP makes it clear that such modifications teach away from Applicant's invention.

Applicant further incorporates herein by reference the remarks in the response to the final office action and the prior traverse of the combination of references. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 1, 7 and 13.

Claims 2 to 5 depend from Claim 1 and so distinguish over the combination of reference for at least the same reasons as Claim 1. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 2 to 5.

Claims 8 to 11 depend from Claim 7 and so distinguish over the combination of reference for at least the same reasons as Claim 7. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 8 to 11.

Claims 14 to 17 depend from Claim 13 and so distinguish over the combination of reference for at least the same reasons as Claim 13. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 14 to 17.

Claims 6, 12, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nguyen in view of Speciner and further in view of U.S. Patent No. 5,335,316, hereinafter referred to as Toyokura.

Applicant respectfully traverses the obviousness rejection. Assuming the combination of the three references is proper, the information from Toyokura fails to cure the deficiency of the two primary references. In addition, there has been no showing how the sequential process of the primary reference would still perform the one pass process with the proposed modifications, and so the combination is not well founded. Thus, each of Claims 6, 12, and 18 distinguishes over the combination of references for at least the same reasons as the independent claim from which it depends. Applicant

requests reconsideration and withdrawal of the obviousness rejection of each of Claims 6, 12, and 18.

Claims 19 and 20 stand rejected as anticipated by Nguyen. The above comments concerning, transparent objects, lists, and the sequence of operations in Nguyen are incorporated herein by reference. Moreover the rejection failed to cite any teaching of a non-transparent object that included a plurality of text words that overlapped the transparent graphics object, and the **entire** non-transparent object including the plurality of words was added to the list. In Fig. 4, Nguyen shows two elements 170, 172 overlapping the bitmap. Neither element 170 nor element 172 includes a plurality of text words. Each element includes only a single word. Neither element 170 nor element 172 teaches what is done with an element that includes a plurality of text words as recited in Claim 19. Hence, Nguyen fails to teach the invention of Claim 19 to the same level of detail as recited in the Claim. There is no citation of considering when the entire plurality of words overlap and considering when only some of the plurality of words overlap and in both cases adding the entire object containing the plurality of words to the list. Therefore, Claims 19 and 20 distinguish over Nguyen. Applicant requests reconsideration and withdrawal of the anticipation rejections of Claims 19 and 20.

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Appl. No. 09/728,717

Amdt. dated November 29, 2005

Reply to Advisory Action of October 19, 2005

Claims 1 to 20 remain in the application. Claim 1, 4, 7, 10, 13, 16, 19 and 20 are amended. For the foregoing reasons, Applicant(s) respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on November 29, 2005.



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November 29, 2005
Date of Signature

Respectfully submitted,



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